

IN THE  
**Supreme Court of the United States**  
OCTOBER TERM, 1995

**HERBERT MARKMAN and POSITEK, INC.,**  
*Petitioners,*

vs.

**WESTVIEW INSTRUMENTS, INC., and  
ALTHON ENTERPRISES, INC.,**  
*Respondents.*

ON WRIT OF CERTIORARI  
TO THE UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

**BRIEF OF AMICUS CURIAE AMERICAN  
INTELLECTUAL PROPERTY LAW ASSOCIATION  
IN SUPPORT OF RESPONDENTS**

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## **QUESTION PRESENTED**

The question presented has been inaccurately stated by the petitioners. The question that this case actually presents is as follows:

Is the determination of the meaning of a word in a patent claim an issue of law or an issue of fact?

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BRIEF OF AMERICAN INTELLECTUAL PROPERTY LAW  
ASSOCIATION AS *AMICUS CURIAE*  
IN SUPPORT OF RESPONDENTS

—  
This *amicus curiae* brief is submitted in support of the Respondents. Both Petitioners and Respondents have consented to the filing of this brief. Their written consent has been filed with the Court.

## INTEREST OF THE *AMICUS*

The American Intellectual Property Law Association ("AIPLA") is a national association of more than 9,000 members whose interest and practice lie in the areas of patent, copyright, trademark, trade secret and other intellectual property law. The AIPLA's members include attorneys in private practice and attorneys employed by corporations, universities, and government. Unlike many other areas of practice in which separate and distinct plaintiffs' and defendants' bars exist, most, if not all, intellectual property law attorneys represent both plaintiffs and defendants.

The AIPLA is very interested in the outcome of the present appeal. More specifically, the AIPLA strongly believes that the Federal Circuit's decision on appeal to this Court should be affirmed. The interests of patent litigants represented by our members would be directly and adversely affected if a trial, whether by jury or otherwise, were necessary to determine the scope of rights granted in a United States patent -- a question of law. While the AIPLA is very interested in the preservation of Seventh Amendment rights in intellectual property litigation, it opposes their radical expansion to hearings over issues of law. Most importantly, the AIPLA wishes to preserve the public notice function of patents and their accompanying administrative record, upon which industry must rely without resorting to litigation.

## SUMMARY OF ARGUMENT

Because petitioners have improperly stated the question presented, this *amicus* brief has set forth the question actually presented in this case: Is the determination of the meaning of a word in a patent claim an issue of law or an issue of fact? The petitioners' question improperly assumes that there are "genuine factual disputes" concerning the construction of a term in a patent claim. Because this Court has repeatedly held that claim construction is a question of law to be determined by the court, the Seventh Amendment concerns raised by the petitioners are simply not implicated.

This Court should not now reconsider the long-standing rule that claim construction is a question of law, even in cases where a court elects to hear live testimony regarding the meaning of a term in the patent claim. The use of such testimony does not transform questions of law into questions of fact. This Court has repeatedly authorized district courts to hear expert testimony to resolve questions of statutory interpretation involving technical terms which are unfamiliar to the court.

Lastly, this Court should preserve the important public notice function of patents and their accompanying file histories, the patent's official administrative record. Under no circumstances should patent litigants be able to contradict that public record by the introduction of expert testimony. Accordingly, courts should be free to reject as a matter of law any testimony which attempts to alter the public record on which industry must rely. Industry should not be required to participate in protracted litigation just to learn the meaning of a patent.

## ARGUMENT

### I. THE QUESTION PRESENTED IMPROPERLY ASSUMES THAT CONSTRUCTION OF PATENT CLAIMS INVOLVES QUESTIONS OF FACT

The question presented by this case is improperly stated in the petitioners' brief. As stated by the petitioners, the question presented is a rhetorical one: Must questions of fact be tried to a jury in an action for damages? Of course they must. No attorney familiar with the Seventh Amendment to the United States Constitution would argue otherwise.

The petitioners' rhetorical question, however, assumes that the interpretation of patent claims is a factual inquiry, not a legal one. Indeed, the petitioners make this assumption explicitly. On Page 18 of its brief, the petitioners expressly assume that "[t]he task of determining what the claims mean to one 'of skill in the art' is a factual inquiry." No citation follows this assumption.

The question truly presented by this case, as the Federal Circuit recognized, is whether the construction of words in a patent claim is a question of law or a question of fact. The Federal Circuit held it to be a question of law. If that is correct, claim construction may properly be resolved by a motion for summary judgment, a motion for a directed verdict, or through the preparation of jury instructions. See Fed. R. Civ. P. 50, 51, 56. If claim construction is a question of fact, in contrast, genuine disputes about claim construction must be decided by trial.

This case, therefore, is not important because of any imaginary constitutional concerns. Rather, this case is important -- exceedingly so -- because it will determine whether a trial is necessary on issues of patent law which historically have been decided by the courts as a matter of law without a trial.

The AIPLA is very concerned about the outcome of this case because a reversal by this Court would have a devastating impact on the litigation of patent cases. While trials are the best means for resolving questions of fact, they are poorly suited for resolving questions of law. A trial to determine the legal meaning and effect of public rights granted by the federal government -- by statute, by patent, or otherwise -- would be truly revolutionary. It would also be a serious mistake. A party would be entitled to a trial merely because of a disagreement over the meaning of a legal text.

Moreover, as the petitioners correctly observe, the parties always disagree over the scope and meaning of the rights granted by a patent. Thus, if this Court were to conclude that a trial is the appropriate vehicle to determine the scope of these rights, summary judgment would have virtually no place in patent litigation. Mere disagreement over the meaning of a legal text would entitle the parties to a trial. The just and speedy resolution of legal disputes promised by Rule 1 of the Federal Rules of Civil Procedure would become illusory in all future patent infringement cases.



## II. CLAIM CONSTRUCTION IS A QUESTION OF LAW FOR THE COURT

### A. This Court's Precedents Clearly Establish That Claim Construction Is A Question Of Law

On at least three occasions, this Court has squarely held that the construction of patent claims is a question of law to be decided exclusively by the court. See *Coupe v. Royer*, 155 U.S. 565, 579 (1895); *Bates v. Coe*, 98 U.S. 31, 38-39 (1878); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 338 (1853). This Court's holdings are clear and leave no room for reasonable debate.

For example, in the earliest of the cases, this Court unequivocally explained:

On such a trial [of patent infringement], two questions arise. The first is, what is the thing patented; the second, has that thing been constructed, used or sold by the defendants.

*The first is a question of law, to be determined by the court, construing the letters patent, and the description of the invention and specification of claim annexed to them.* The second is a question of fact, to be submitted to a jury.

*Winans*, 56 U.S. (15 How.) at 338 (emphasis added).

Similarly, in *Coupe*, this Court quoted the leading patent law treatise of the day to reiterate the proper division of authority between judge and jury. As this Court explained:

Where the defense "denies that the invention used by the defendant is identical with that included in the plaintiff's patent, *the court defines the patented invention as indicated by the language of the claims*; the jury judge whether the invention so defined covers the art or article employed by the defendant."

*Coupe*, 155 U.S. at 579 (quoting 3 WILLIAM C. ROBINSON, TREATISE ON THE LAW OF PATENTS FOR INVENTIONS § 1075 at 378 (Boston, Little, Brown & Company 1890)).

Again, in *Bates*, this Court held clearly and unequivocally that claim construction is a question of law for the court:

In construing patents, it is the province of the court to determine what the subject-matter is upon the whole face of the specification and the accompanying drawings.

*Bates*, 98 U.S. at 38-39.

In the present case, the Federal Circuit merely re-affirmed the vitality of this Court's decisions in *Winans*, *Coupe*, and *Bates*, and overruled one line of its own earlier decisions that had deviated from this Court's precedents. *Markman v. Westview Instruments*, 52 F.3d 967, 977-79 (Fed. Cir.), cert. granted, 116 S. Ct. 40 (1995). The vast majority of prior Federal Circuit decisions had likewise followed this Court's precedents to the letter. The Federal Circuit has repeatedly held that claim construction is a question of law for the court, while infringement of the claim as construed by the court is a question of fact for the



jury when properly demanded. See, e.g., *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 822 (Fed. Cir. 1992) (quoting *Winans*, 56 U.S. (15 How.) at 338); *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 1569 (Fed. Cir. 1983).

Moreover, contrary to the petitioners' argument, the Federal Circuit's adherence to this Court's precedents will not create practical difficulties in the district courts. The district courts have been construing patent claims as a matter of law throughout the history of our Nation. See, e.g., *National Car-Brake Shoe Co. v. Terre Haute Car & Mfg. Co.*, 19 Fed. 514, 515-16 (C.C.D. Ind. 1884); *Emerson v. Hogg*, 8 F. Cas. 628, 631 (C.C.S.D.N.Y. 1845).

The petitioners rely primarily upon *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812 (1870), and *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453 (1872), as contrary authority from this Court. See Pet'r Br. at 31-34. These decisions, however, are entirely irrelevant.

In both *Bischoff* and *Tucker*, this Court held that the *novelty* of an invention claimed in a patent is a question of fact for the jury to decide in an action at law. Thus, in an action at law, a jury must compare the patent in suit to earlier patents, publications, and devices to decide whether the patented invention is novel. The Federal Circuit still follows this rule today. E.g., *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613 (Fed. Cir.), *cert. dismissed*, 474 U.S. 976 (1985). *Bischoff* and *Tucker* say absolutely nothing about the question before this Court -- whether the claims of a patent should be construed by a judge as an issue of law or by a jury as an issue of fact.

Indeed, this error infects the petitioners' entire brief, and the briefs of many of the *amici curiae*. Repeatedly throughout their briefs, the petitioners and various *amici* cite and discuss cases holding that the novelty of a patent or the adequacy of a patent's disclosure are questions of fact for the jury. Pet'r Br. at 23-25, 31-35; *Amicus* Br. of Litton Systems, Inc. at 16, 18-19; *Amicus* Br. of American Trial Lawyers Association at 5-7. These cases say nothing about claim construction. The petitioners and the *amici* have simply confused very distinct inquiries.

## **B. This Court's Precedents Are Correct**

### **1. The Legal Scope And Effect Of The Exercise Of Congressional Power Is Plainly A Question Of Law**

This Court's precedents holding patent claim interpretation to be a question of law, not a question of fact, are clearly correct. Although this Court has observed that the distinction between "law" and "fact" is sometimes "vexing," *Pullman-Standard, Div. of Pullman, Inc. v. Swint*, 456 U.S. 273, 288 (1982), patent claim construction clearly falls on the "law" side of the dichotomy.

The United States Constitution grants Congress the power "To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." U.S. CONST. art. I, § 8, cl. 8. Congress has chosen to exercise this power through the issuance of patents by the United States Patent and Trademark Office ("PTO"), rather than through special legislation defining the limits of each inventor's exclusive rights.

Congress' choice of methods, however, should not obscure the legislative nature of the power exercised by Congress and the PTO. Congress has, on occasion, granted inventors the exclusive right to their discoveries by special statute. See 1 WILLIAM C. ROBINSON, TREATISE ON THE LAW OF PATENTS FOR INVENTIONS §§ 46-47 (Boston, Little, Brown & Company 1890) and 2 WILLIAM C. ROBINSON, TREATISE ON THE LAW OF PATENTS FOR INVENTIONS § 429 (Boston, Little, Brown & Company 1890); see also P.J. Federico, *The First Patent Act*, 14 J. Pat. Off. Soc'y 237 (July 1932) (describing petitions for patents addressed to the first Congress). These statutes, defining the scope of the inventors' rights, plainly must be construed as a matter of law. There is no sound reason why those same rights, granted by an administrative agency under power delegated by Congress, should be construed as a matter of fact.

Moreover, a patent, like a statute or regulation, defines legal rights and forbids the public from intruding upon those rights. The scope and meaning of such legal rights is plainly the type of question that courts have historically resolved in the context of statutory interpretation as a question of law. Again, there is no reason why interpretation of the scope of similar rights should be different in the context of patent claim construction. The Federal Circuit was thus entirely correct in analogizing interpretation of patents to interpretation of statutes and concluding that both are pure questions of law. See *Markman*, 52 F.3d at 987.

## 2. This Court's Precedents Do Not Unconstitutionally Depart From The English Common Law

Petitioners rely upon a series of English cases in an effort to establish that claim construction was a jury question at the time the Seventh Amendment was adopted. See Pet'r Br. at 23-26. Implicitly, petitioners seek to have this Court overturn cases such as *Coupe*, 155 U.S. at 579; *Bates*, 98 U.S. at 38-39; and *Winans*, 56 U.S. (15 How.) at 338, on constitutional grounds.

The English cases, however, require no such drastic step. Like this Court's decisions in *Bischoff* and *Tucker*, the English cases relied upon by petitioners merely hold that the novelty of a patented invention is a question for the jury in actions at law. This is made clear by petitioners' own description of those cases. See Pet'r Br. at 23-26. Like *Bischoff* and *Tucker*, petitioners' English cases do not address the question before this Court.

## C. Claim Construction Involves No Underlying Questions Of Fact

Petitioners and the dissent below criticized the Federal Circuit's *in banc* opinion for authorizing the district courts to hear live expert testimony to resolve a question of law. Pet'r Br. at 45-46; *Markman*, 52 F.3d at 1006 (Newman, J., dissenting). This, they argued, establishes that claim construction is necessarily based upon underlying questions of fact.

This unsupported assertion is simply untrue. This Court has long authorized district courts to hear live expert



testimony to resolve questions of statutory interpretation involving technical terms that are unfamiliar to the court. See *Order of Railway Conductors of America v. Swan*, 329 U.S. 520, 525-28 (1947). Indeed, this Court has held that "proof of established usage may be proper or even indispensable, in fixing the just interpretation of the law." *Binns v. Lawrence*, 53 U.S. (12 How.) 9, 18 (1851). Accordingly, in both *Railway Conductors* and *Binns*, this Court approved precisely the sort of pre-trial hearing of expert testimony which the Federal Circuit endorsed in *Markman*. Compare *Railway Conductors*, 329 U.S. at 525-28 and *Binns*, 53 U.S. (12 How.) at 18, with *Markman*, 52 F.3d at 980-81. Thus, the use of expert testimony to aid the court in understanding technical words does not change any issue from one of law to one of fact.

Similarly, Litton Systems, Inc., as *amicus curiae*, makes much of the fact that patent claims are addressed to those skilled in the technical arts, not to lawyers. This, Litton argues, distinguishes patents claims from statutes and establishes that claim construction is based on underlying factual findings. This argument, however, rests upon the unstated assumptions that statutes are always addressed to lawyers and that only documents addressed to lawyers may be construed as a matter of law. As this Court's decisions in *Railway Conductors* and *Binns* make clear, statutes -- like patent claims -- are often addressed to those skilled in the technical arts or other specialized fields, and these statutes are construed by the court as a matter of law.

### III. TESTIMONY CONTRARY TO A PATENT SPECIFICATION AND ITS OFFICIAL ADMINISTRATIVE RECORD DOES NOT RAISE A TRIABLE ISSUE OF FACT

Even if factual issues could arise in determining the legal scope and effect of a patent, they do not arise in the present case. As the Federal Circuit thoroughly explained in its opinion, the patent at issue and its file history unequivocally establish the meaning of the disputed claim term, "inventory." See *Markman*, 52 F.3d at 982-83. The opinion testimony offered by the petitioners below was inconsistent with these documents and thus was properly rejected as a matter of law. *Id.*

The petitioners do not even argue that the opinion testimony it offered below was consistent with the public record. Nevertheless, the petitioners have asked this Court to order a trial on the issue of claim construction. Apparently, the petitioners would like the trier of fact to determine, as a question of fact, whether the opinion testimony he offered should be given greater weight than the undisputed, unambiguous content of his patent and file history.

The petitioners' request is dangerous and inconsistent with the very nature of patents. As this Court has often explained, patents serve an important public notice function. The patent must:

"inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or



manufactured without a license and which may not."

*Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 214-15 (1940) (quoting *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 60 (1931)). See also *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938); *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356, 434-35 (1822).-

This function would be destroyed if patent holders were able to change the scope of their rights merely by introducing testimony that contradicts the public record. The public is entitled to rely upon the public record and should not be subjected to the uncertainties of a trial based on evidence directly contradictory to that record.

For this reason, the Federal Circuit has established a clear hierarchy of claim construction tools. The patent specification and its file history are an immutable public record and provide the principal claim construction tools. Expert opinion that is inconsistent with these sources is not probative of the proper claim construction. See *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88 (Fed. Cir. 1992) (collecting cases); *Senmed, Inc. v. Richard-Allan Medical Indus., Inc.*, 888 F.2d 815, 819 (Fed. Cir. 1989). See also *White v. Dunbar*, 119 U.S. 47, 51 (1886) (a patent holder may not "suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction").

This Court has already adopted a similar approach in connection with statutory construction. Expert testimony may be used to aid the Court's construction, *Railway Conductors*, 329 U.S. at 525-28; *Binns*, 53 U.S. (12 How.)

at 18, but expert testimony may not be used to contradict the statutory language. *Binns*, 53 U.S. (12 How.) at 19. This Court should affirmatively endorse the Federal Circuit's application of this rule to claim construction and reject the petitioners' attempt to destroy the public notice function of patents.

## CONCLUSION

This Court should uphold the *in banc* decision of the Federal Circuit. That court was correct in concluding that the issue of claim construction is one of law and that, in any event, there was no genuine issue of material fact warranting a trial on the meaning of the term "inventory" in the asserted patent claims.

Respectfully submitted,

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